

REMARKS

This communication responds to the Office Action mailed on June 2, 2006. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-16 are now pending in this Application.

Information Disclosure Statement

The Applicant submitted an Information Disclosure Statement and a 1449 Form on September 5, 2003. The Applicant respectfully requests that an initialed copy of the 1449 Form be returned to the Applicant's Representative to indicate that the cited documents have been considered by the Examiner.

§112 Rejections of the Claims

Claims 1-16 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. To support this rejection, the Office asserts that "[w]ith respect to claims 1 and 11, applicant's does not describe in the specification in such a way as to reasonably convey to one skilled in the relevant art that has support for 'substantially flat interface.' Instead, applicant has support for only a 'flat interface.'" The Applicant respectfully disagrees.

Claims 1 and 11 were previously amended to make clear that the alignment weight claimed by the Applicant includes depressions having a substantially "flat interface" to receive a plurality of pins (see the interface in the depressions 108 shown in FIG. 3 of the Application, receiving the ends 314 of the pins 302), and the support for the presence of this "flat interface" is acknowledged in the Office Action.

The term "substantially" simply modifies the claimed element of a "flat interface". It is respectfully noted that the Federal Circuit has remarked that "[c]laims need only 'reasonably apprise those skilled in the art' as to their scope to satisfy the definiteness requirement ... In addition, the use of modifiers in the claim, like 'generally' and 'substantial,' does not by itself render the claims indefinite." *Energy Absorption Sys., Inc. v. Roadway Safety Servs., Inc.* Civ. App. 96-1264 (Fed. Cir. July 3, 1997)

(unpublished) (citing *Hybritech v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987)).

Similarly, in *VerveLLC v. Crane Cams Inc.*, the Federal Circuit held that the word "substantially" was definite, and stated:

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as "substantially equal" and "closely approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995). **It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite.** *VerveLLC v. Crane Cams, Inc.*, 311 F.3d 1116 (Fed. Cir. 2002) (emphasis added)

The M.P.E.P. § 2164 *et seq.* notes that the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. Such a case requires:

1. a rational basis as to
 - a. why the disclosure does not teach, or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and

6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

“The Examiner must provide evidence ... supporting each of these elements for a rejection under the first paragraph of § 112 to be proper.” See *Patent Prosecution, Practice and Procedure Before The United States Patent Office*, Ira H. Donner, pg. 691, 2002.

Since the Office admits that there is support for a “flat interface” in the specification, and since the courts approve using the claim language modifier “substantially” when understood by those of ordinary skill in the art, the required evidence to support a rejection of non-enablement under § 112, first paragraph is not present in the record, and a *prima facie* case has not been established. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 11-16 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office noted that “it is unclear whether the applicant is claiming the alignment weight apparatus or whether the applicant is claiming the resultant structure of the circuit board and pins.” In response, the Applicant respectfully notes that the claims are clearly directed to an apparatus comprising at least the following structural elements: (a) an alignment weight, (b) a circuit board, and (c) a plurality of pins.

To make out a *prima facie* case of indefiniteness, three elements must be shown: interpretation of the claim in light of the specification; interpretation of the claim as one of ordinary skill in the art would interpret it; and that the limitations in the claim, or the subject matter not in the claim, does not reasonably define the invention. It is noted that “[in] relation to Section 112, second paragraph, the Examiner has the burden of showing that the proposed claim language is indefinite to one of skill in the art.” See *Patent Prosecution: Practice and Procedure Before the U.S. Patent Office* by Irah H. Donner, pg. 831, 2002. This type of showing has not been made.

The Applicant believes that one of skill in the art would have no difficulty in determining the subject matter which the Applicant regards as the invention (i.e., a combination of an alignment weight, a circuit board, and a plurality of pins), and thus the Applicant declines to amend claims 11-16 at this time. Since no *prima facie* case of indefiniteness has been

established, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 11-16 under 35 USC § 112, second paragraph.

Allowable Subject Matter

Even though the Office asserts that claims 1-16 are rejected under 35 USC § 112, first paragraph, the Office Action is silent with respect to claims 7-10. That is, this rejection of claims 1-16 is based on the claim language modifier “substantially,” which is not present in claims 7-10. Therefore, the Applicant believes claims 7-10 are in condition for allowance, and such is respectfully requested. However, if this is not the case, the Applicant respectfully requests that the Office set forth any concerns with respect to claims 7-10 in a subsequent, non-final action so the Applicant may be afforded a full and fair chance to address them.

CONCLUSION

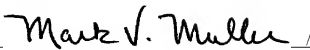
The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant’s attorney ((210) 308-5677) to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHERYL M. WALDRON-FLOYDE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, Minnesota 55402
(210) 308-5677

By /  /
Mark V. Muller
Reg. No. 37,509